

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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*Ex parte* KEITH BARRACLOUGH, BRYAN R. MARTIN, and KEVIN DEIERLING

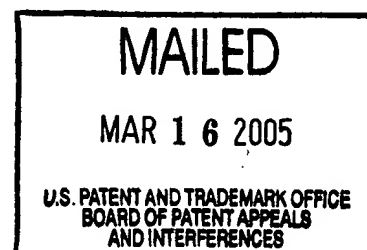
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Appeal No. 2004-1497  
Application No. 08/941,975

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ON BRIEF

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Before KRASS, BARRY, and BLANKENSHIP, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

**REMAND OF APPEALS**

A patent examiner rejected claims 1-14. The appellants cancel claim 6 and appeal the rejection of claims 1-5 and 7-14 under 35 U.S.C. § 134(a). (Appeal Br. at 1.) We remand.

In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, after considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54

USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). Our opinion addresses the following deficiencies in the order in which they appear in the examiner's answer:

- sole reliance on English abstract
- incomplete summary of invention.

#### A. SOLE RELIANCE ON ENGLISH ABSTRACT

"Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art." *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd.Pat.App. & Int. 2001). "[A] proper examination under 37 CFR § 1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." *Id.* "To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." M.P.E.P. § 706.02.

Here, the examiner reject the claims on appeal over a Japanese Kokai Publication to Iwasaki. In doing so, he cites to an English abstract of Iwasaki, without

relying on the underlying Publication itself. Although the examiner provides a copy of the Japanese Publication, moreover, he purposefully omits a translation thereof.

(Examiner's Answer at 7.)

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard to examine the application and resolve patentability in the first instance." *Braeken*, 54 USPQ2d at 1112. To the contrary, "obtaining translations is the responsibility of the examiner." *Jones*, 62 USPQ2d at 1209. Therefore, a translation of Iwasaki is needed for our review of the rejections.<sup>1</sup> Furthermore, the examiner should base his rejections on the translation, citing thereto.

#### B. INCOMPLETE SUMMARY OF INVENTION

An appeal brief shall contain "[a] concise explanation of the invention defined in the claims involved in the appeal, which **shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.**" 37 C.F.R. § 1.192(c)(5)(2000) (emphases added).<sup>2</sup> "[R]eference to page and line number of the

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<sup>1</sup>Besides our review, a review by the examiner and the appellants of the translation also "may supply additional relevant evidence. . . ." *Jones*, 62 USPQ2d at 1209.

<sup>2</sup>We cite to the version of the C.F.R. at the time of the appellants' brief.

specification . . . is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." M.P.E.P. § 1206.

Here, the *Summary of Invention* section of the appellants' brief, (Appeal Br. at 2-3), does not read the claims on the specification and drawings. We decline to substitute speculation about where the claimed subject matter is described in the application for the greater certainty that should come from the appellants in a more specific summary of their invention. Instead, the appellants should read each of the separately argued claims on their specification and drawings. In particular, a mapping of each of the claimed limitations to specific pages and lines of the specification and reference characters of the drawings is needed for a meaningful review.

### CONCLUSION

For the aforementioned reasons, the application is remanded to the examiner to prepare a substitute examiner's answer correcting the aforementioned deficiencies. The substitute answer should be self-contained with respect to all rejections and arguments; no prior examiner's answer or Office action should be referenced or incorporated therein. Similarly, any brief submitted by the appellants should be self-contained with respect to all arguments; no prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

  
ERROL A. KRASS )  
Administrative Patent Judge )

  
LANCE LEONARD BARRY  
Administrative Patent Judge

BOARD OF PATENT  
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*Howard B. Blankenship*  
HOWARD B. BLANKENSHIP  
Administrative Patent Judge

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